

Remarks:

Applicants appreciatively acknowledge the Examiner's confirmation of receipt of Applicants' claim for priority and certified priority document under 35 U.S.C. § 119(a)-(d).

Reconsideration of the application, as amended herein, is respectfully requested.

Claims 1 - 18 are presently pending in the application. Claims 1, 2, 13 - 16 and 18 have been amended. As it is believed that the claims were patentable over the cited art in their original form, the claims have not been amended to overcome the references.

Applicants note that the no prior art was cited against the claims of the instant application in the above-identified Office Action. As such, it is believed that the instant claims are patentable over the art of record, as MPEP § 707.07 and 37 C.F.R. § 1.101(b) require an **Examiner's action to be complete as to all matters**. Because no prior art rejections were made in the instant application, subject to Applicants' addressing the objection to claim 18 and the 35 U.S.C. § 101 and 112 rejections set forth in the Office Action, Applicants' claims are believed to be in condition for allowance. Applicants have addressed the objections/rejections of the Office Action, herebelow.

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More particularly, in item 1 of the Office Action, claim 18 was objected to on the basis of an informality. Claim 18 has been amended to depend from claim 2, rather than from independent claim 1 of the instant application.

In item 3 of the above-identified Office Action, claims 13 - 16 were rejected as allegedly being indefinite under 35 U.S.C. § 112, first paragraph. More specifically, it was alleged in the Office Action that claim 13 set forth a single "means" claim, covering every conceivable means for generating a sequence of random numbers of 1/f noise. Claims 14 - 16 were rejected on similar grounds.

Applicants have amended claims 13 - 16 to replace the word "means" with the phrase "processor programmed". As such, claims 13 - 16 presently recite definite structure, and are no longer "means" clauses subject to 35 U.S.C. § 112, paragraph 6 or MPEP § 2164.08(a). It is accordingly believed that Applicants' claims meet the requirements of 35 U.S.C. § 112, first paragraph.

In item 5 of the Office Action, claims 1 - 18 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter for allegedly failing to produce a

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useful, concrete and tangible result. Applicants' respectfully traverse the above rejections, as applied to the amended claims.

More particularly, under the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility, dated November 22, 2005 (the "Interim Guidelines"), the claimed invention must produce a useful, concrete and tangible result. Applicant's claimed invention does indeed produce such a useful, concrete and tangible result.

More particularly, Applicant's independent claims 1 and 2 are directed towards methods for generating at least one sequence of random numbers of 1/f noise. Such methods produce useful results, i.e., the resultantly generated at least one sequence of random numbers of 1/f noise. To make this even more clear, Applicants' have amended claim 1 to recite, among other limitations:

outputting the at least one sequence of random numbers of 1/f noise. [emphasis added by Applicants]

Similarly, Applicants' independent claim 2 has been amended to recite, among other limitations:

outputting at least one of the q sequences of random numbers of 1/f noise. [emphasis added by Applicants]

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As such, Applicants' claims 1 and 2 have been amended to recite **"outputting" of the generated sequence** in order to further emphasis the concrete and tangible result of the claimed method. Producing and providing such an **output** demonstrates that the invention of Applicant's claims 1 and 2 are not merely a disembodied mathematical concept which may be characterized as an 'abstract idea', but rather is a method that produces and outputs a useful, concrete and tangible result (i.e., **at least one sequence generated**). According to the Interim Guidelines, it has been found that the transformation of data on a computer can produce a useful, concrete and tangible result. See Interim Guidelines citing the Courts decisions in State Street Bank and AT&T:

. . . State Street, 149 F. 3d at 1373-74, 47 USPQ2d at 1601-02 ("the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation because it produces a 'useful, concrete and tangible result' - a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.."). Also see AT&T, 172 F.3d at 1358, 50 USPQ2d at 1452 (Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held patentable subject matter because the process used the algorithm to produce a useful, concrete, tangible result without preempting other uses of the mathematical principle.).

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The remainder of Applicants' claims 3 - 18 include all of the limitations of Applicants' claim 1 or claim 2, by incorporating those claims therein.

It is, thus, believed that the pending claims constitute statutory subject matter under 35 U.S.C. § 101.

Further, in item 7 of the Office Action, claims 1 - 18 of the instant application were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 - 2, 5 - 6, 16, 18, 27 - 30, 37 - 38 and 41 - 42 of copending Application No. 10/289,827.

Applicant submits that a terminal disclaimer can be filed in one of the present application and co-pending Application No. 10/289,827, if the claims of the present application and the claims in the co-pending Application No. 10/289,827, remain obvious in view of each other at the time of allowance of either of these applications. For example, MPEP § 804(I)(B)(1) states, in part:

If a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining **in the earlier filed** of the two pending applications, while the later-filed application is rejectable on other grounds, **the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer**. If the ODP rejection is the only rejection remaining **in the later-filed application**, while the earlier-filed application is rejectable on other grounds, **a terminal disclaimer must be required in the**

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later-filed application before the rejection can be withdrawn.

If "provisional" ODP rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. [emphasis added by Applicants]

In all of the above-discussed cases, the terminal disclaimer is to be filed in the later-filed application, once an application has been found to be allowable. Once the terminal disclaimer is required in the later-filed application, it appears from MPEP § 804 that the provisional rejection is to be withdrawn in the earlier-filed application.

As it is believed that, but for the provisional ODP rejections, both applications are in condition for allowance (see, the Response filed on June 9, 2006 in co-pending Application No. 10/289,827), Applicants respectfully request that the provisional ODP rejection in the earlier-filed case be withdrawn, and that that application be allowed to issue.

Applicants note that the present application includes **the earliest claimed** priority date under 35 U.S.C. § 119 from a German Application filed on December 22, 2000, whereas co-pending patent application no. 10/289,827 claims priority

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under 35 U.S.C. § 119 from a German Application filed on November 7, 2001. Additionally, the present case is a continuation application of PCT/DE0104376 filed on November 22, 2001, which is prior to the U.S. filing date of the co-pending patent application no. 10/289,827 of November 7, 2002. As such, Applicants believe that the instant application is the "earlier-filed" application and respectfully request that the double patenting rejection be withdrawn in the instant case. However, if the determination of the earlier-filed application is based on the filing date in the United States, or on some other basis, and if the double patenting rejection is not withdrawn in connection with the instant application, Applicants respectfully request that the Examiner inform the Applicants in the next action of the date being used to determine which application was "earlier-filed" for purposes of the request for a terminal disclaimer.

Applicants further reserve the right to argue differences between the inventions disclosed in co-pending Application No. 10/289,827 and the instant application, at a later date, to possibly show that a terminal disclaimer should not be required in either case.

In view of the foregoing, reconsideration and allowance of claims 1 ~ 18 are solicited.

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In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

If an extension of time for this paper is required, petition for extension is herewith made.

Please charge any fees that might be due with respect to Sections 1.16 and 1.17 to the Deposit Account of Lerner Greenberg Sterner LLP, No. 12-1099.

Respectfully submitted,



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